

**REMARKS**

Applicants have carefully reviewed the Application in light of the Office Action mailed November 19, 2004. At the time of the Office Action, Claims 1-39 were pending in the Application. Applicants amend Claims 1, 10, 13, 24, 33, and 36 and cancel Claims 4, 16, and 27, without prejudice or disclaimer, and add Claims 40-44. Applicants' amendments, cancellations, and additions have been done to advance prosecution in this case and not to overcome prior art. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

**Consideration of Information Disclosure Statement**

Applicants submit an Information Disclosure Statement (IDS) with this Response. Applicants respectfully request the Examiner to review this IDS and to formally indicate that these materials have been considered in the context of the pending prosecution. Applicants suggest the Examiner use a PTO-1449 to provide written notification to this effect.

**Section 102 Rejection**

The Examiner rejects Claims 1-3, 5, 11, 13-15, 17, 22, 24-26, 28, 34, and 36-39 under 35 U.S.C. §102(e), as being anticipated by U.S. Patent No. 6,356,545 issued to Vargo, et al. (hereinafter "*Vargo*"). Applicants respectfully request reconsideration of this rejection of the above mentioned claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. §2131 (*emphasis added*). *Vargo* does not disclose, teach, or suggest, either expressly or inherently, each and every element of the claims.

Applicants amend Claim 1 to include limitations of Claim 4, amend Claim 13 to include limitations of Claim 16, amend Claim 24 to include limitations of Claim 27, and amend Claim 36 to include limitations of Claim 4. *Vargo* fails to disclose, teach, or suggest

each and every element of Applicants' amended Claim 1, either expressly or inherently. For example, Claim 1 includes "selecting one of a plurality of codecs [that] comprises: retrieving pre-stored codec selection data that associates the at least one network parameter to a corresponding codec; and selecting the corresponding codec using the pre-stored codec selection data." Because *Vargo* fails to teach at least these limitations, Applicants respectfully submit that *Vargo* cannot anticipate Claim 1 under 35 U.S.C. §102(e). Thus, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependents.

Independent Claims 13, 24, and 36 each recite certain limitations that, for reasons substantially similar to those discussed with reference to independent Claim 1, *Vargo* does not disclose, teach, or suggest, either expressly or inherently. Therefore, Applicants respectfully request reconsideration and allowance of independent Claims 13, 24, and 36 together with their dependents.

### **Section 103 Rejection**

The Examiner rejects Claims 12, 23, and 35 under 35 U.S.C. §103(a), as being unpatentable over *Vargo* in view of U.S. Patent No. 6,798,786 issued to Lo, et al. (hereinafter "*Lo*"). To defeat a patent under 35 U.S.C. §103(a), the claimed *combination* must be obvious. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 U.S.P.Q. 603 (Fed. Cir. 1984). Therefore, it is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987).

Applicants respectfully submit that the combination fails to disclose, teach, or suggest each limitation recited in Applicants' claims. Dependent claims 12, 23, and 35 that depend upon Claims 1, 13, and 24, respectively include limitations of their independent claims and add additional elements that further distinguish the combination. The combination of *Vargo* and *Lo* does not disclose, teach, or suggest the limitations recited in Claims 12, 23, and 35. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

**Allowable Subject Matter**

Applicants note with appreciation the Examiner's allowance of Claims 4, 6-10, 16, 18-21, 27, and 29-33. The Examiner indicates that the subject matter of these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *Office Action*, p. 10. Applicants cancel Claims 4, 16, and 27. Claims 1, 13, and 24 have been amended to include the limitations of canceled Claims 4, 16, and 27, respectively. Claims 6-10, 18-21, and 29-33 depend on allowable Claims 1, 13, and 24. Applicants respectfully submit that Claims 1, 6-10, 13, 18-21, 24, and 29-33 are now allowable, and Applicants request reconsideration and allowance of all pending claims.

**New Claims**

Applicants add new Claims 40-44, which are fully supported by the specification of the present Application as originally filed. Independent Claim 40 includes limitations of objected Claim 6, independent Claim 41 includes limitations of objected Claim 7, independent Claim 42 includes limitations of objected Claim 8, independent Claim 43 includes limitations of objected Claim 9, and independent Claim 44 includes limitations of objected Claim 10. Neither *Vargo* nor *Lo*, alone or in combination, disclose, teach, or suggest the limitations of new Claims 40-44. Accordingly, Applicants respectfully request consideration and allowance of new Claims 40-44.

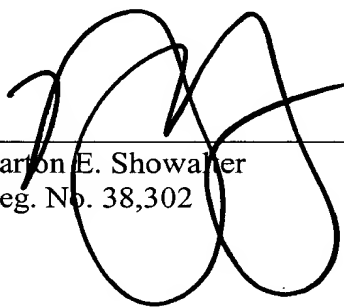
**CONCLUSION**

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicants respectfully requests reconsideration and allowance of the pending claims.

Applicants submit a check in the amount of \$850.00 to cover the fee for the additional claims. Applicants also submit a check in the amount of \$180.00 to cover the cost of the IDS filing fee. The Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Barton E. Showalter, at (214) 953-6509.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
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Date: December 15, 2004

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